

REMARKS

Applicants have carefully studied the outstanding Office Action. The present amendment is intended to place the application in condition for allowance and is believed to overcome all of the objections and rejections made by the Examiner. Favorable reconsideration and allowance of the application are respectfully requested.

Applicants have amended claims **1, 19, 38, 48, 59, 67, 76** and **83** to more properly claim the present invention. No new matter has been introduced. Claims **1 - 36, 38 - 57, 59, 61 - 67, 69 - 74, 76, 78 - 83** and **85 - 89** are presented for examination. Although the Examiner indicated in the Office Action Summary and on page 2 of the Office Action that claim **75** is pending, applicants canceled claim **75** in their amendment of February 22, 2008.

In paragraphs 2 and 3 of the Office Action, the Examiner has rejected claims **1 - 36, 38 - 57, 59, 61 - 67, 69 - 74, 76, 78 - 83** and **85 - 89** under 35 U.S.C. 112, second paragraph, as being indefinite. Applicants have amended the independent claims **1, 19, 38, 48, 59, 67, 76** and **83** accordingly, to recite that the control mark remains unchanged. Although the Examiner included claim **75** in the list of rejected claims in paragraph 3, claim **75** was canceled in applicants' amendment of February 22, 2008.

In paragraphs 4 - 15 of the Office Action, the Examiner has rejected claims **1, 8 - 16, 19, 26 - 34, 38 - 57, 59, 61 - 67, 69 - 74, 76, 78 - 83** and **85 - 89** under 35 U.S.C. §103(a) as being unpatentable over Tsuji et al., U.S. Patent No. 5,764,898 ("Tsuji") in view of Ahern, U.S.

Patent No. 6,769,061 ("Ahern"). Although the Examiner included claims **35** and **36** in the list of rejected claims in paragraph 5, applicants believe that the Examiner's intention is to reject claims **35** and **36** in paragraph 17 of the Office Action, as indicated there.

In paragraph 16 of the Office Action, the Examiner has rejected claims **2 - 7**, and **20 - 25** under 35 U.S.C. §103(a) as being unpatentable over Tsuji and further in view of Scheier et al., U.S. Publication No. 2002/0035584 A1 ("Scheier").

In paragraph 17 of the Office Action, the Examiner has rejected claims **17, 18, 35, 36, 59, 67** and **83** under 35 U.S.C. §103(a) as being unpatentable over Tsuji and further in view of Salzfass et al., U.S. Publication No. 2002/0042815 A1 ("Salzfass").

On pages 9 and 10 of the Office Action, the Examiner has listed prior art made of record. Applicants note that the listed prior art was not included in the Examiner's Form PTO-892.

**Distinctions between claimed invention and (i) U.S. Patent No. 5,764,898 to Tsuji et al. in view of (ii) U.S. Patent No. 6,769,061 to Ahern, (iii) U.S. Publication No. 2002/0035584 A1 to Scheier et al., and (iv) U.S. Publication No. 2002/0042815 A1 to Salzfass et al.**

The claimed invention concerns tracking the distribution of an electronic document as the document is successively routed from sender to recipient, via e-mail (SMTP), via file transfer protocol (FTP), via hyper-text transport protocol (HTTP, and via instant messenger (IM). A document has an embedded control mark that includes a unique identifier (subject specification/ page 8, lines 8 - 14; elements **150** and **155** of **FIG. 1**). Using the control mark, transactions are traced involving documents, a transaction

being sending or receiving the document (subject specification/ page 9, lines 6 – 33; elements **172** and **174** of **FIG. 1**).

Tsuji describes tracking of workstation processing tasks that are to be performed on electronic mail. A sender of electronic mail indicates processing, referred to as “control information” to be performed by one or more recipients of the electronic mail (Tsuji/ col. 2, lines 46 – 49; col. 4, lines 12 – 24; col. 4, line 64 – col. 5, line 4; element **34** of **FIG. 1**; element **41** of **FIG. 3**). The recipient’s processing of the electronic mail is stored within a processing log. (Tsuji/ col. 2, lines 49 – 53; col. 4, lines 31 – 35; element **22** of **FIG. 1**). The sender is thereby able to track the processing of his electronic mail (Tsuji/ col. 3, lines 1 – 7; col. 4, lines 43 – 47; elements **36** and **37** of **FIG. 1**; element **45** of **FIG. 4**).

Ahern describes encoding meta-information using invisible characters such as spaces, tabs, carriage returns, backspaces and line feeds. Two exemplary encodings are provided in **FIGS. 3A** and **3B** for the byte 01100100. Ahern describes a method and system wherein meta-information for a document is first encrypted by a private key of a public-private key pair (Ahern/ step **430** of **FIG. 4**), and the resulting encrypted data is encoded as a sequence of invisible characters (Ahern/ step **440** of **FIG. 4**). The sequence of invisible characters is then appended to a document, which is transmitted to a recipient. If the recipient has an appropriate decoder-decrypter (Ahern/ elements **530** and **540** of **FIG. 5**), then the recipient may extract the meta-information to verify the authenticity of the document. Otherwise, if the recipient does not have an appropriate decoder-decrypter, then the recipient may nevertheless view the document unimpaired, since the encoded characters are rendered by the document reader as invisible characters (Ahern/ col. 5, lines 22 – 35).

Scheier describes a web-based electronic commerce system. Scheier was cited by the Examiner as teaching the limitations of Microsoft Word documents, Microsoft Excel documents, Microsoft Powerpoint documents, Adobe PDF documents, HTML documents and XML documents, and the limitations of FTP downloading, HTTP downloading and Instant Messenger downloading.

Salzfaß describes re-routing of e-mail messages to reach a recipient whose e-mail address has changed, via an e-mail address database and an e-mail forwarding server. Salzfaß was cited by the Examiner as disclosing blocking transmission of an e-mail message to a recipient and issuing a notification.

### **Response to Examiner's Arguments**

In paragraph 6 of the Office Action, the Examiner, in rejecting claim **1**, has indicated that Ahern discloses embedding a control mark within a static section of an electronic document, wherein the static section remains unchanged when the electronic document is edited. Applicants have amended claims **1, 19, 38, 48, 59, 67, 76** and **83** to further clarify that the control mark also remains unchanged when the electronic document is edited. Applicants respectfully submit that the watermark of Ahern may easily be deleted from the electronic document or changed by a document editor. Indeed, as indicated in Ahern at col. 4, lines 59 and 60, the watermark is simply a sequence of invisible characters that are appended to the document. As such, these characters can be removed or changed at will by a document editor. The recipient will still be able to read the document, but will not be able to authenticate it.

In distinction from the claimed invention, Ahern is not concerned with limiting access of the document to authorized recipients. As recited in Ahern at 5, lines 26 – 32, “... a recipient of the document **250** will be able to view the content **250A** of the document ... regardless of whether the receiving device used to receive the document **250** is capable of processing the invisibly encoded watermark.”

In paragraph 13 of the Office Action, in rejecting claim **14**, the Examiner has indicated that Tsuji-Ahern disclose logging the most recent file name of a file storing the electronic document. Applicants respectfully submit that neither Tsuji nor Ahern address the problem of tracking an electronic document when its file name changes.

Applicants note that the Examiner has indicated, in paragraph 15, of the Office Action, that claims **38 – 57, 59, 61 – 67, 69 – 74, 76, 78 – 83** and **85 – 89** all list the same limitations as in claims **1** and **8 – 16**. Applicants respectfully disagree. Inter alia:

- Applicants respectfully submit that claims **38, 48, 76** and **83** relate to network packets, whereas claim **1** relates to e-mail messages. Monitoring transmitted network packets is not one of the limitations in claims **1** and **8 – 16**, and is not addressed in Tsuji and Ahern.
- Applicants respectfully submit that claims **59, 67, 76** and **83** relate to examining a policy to determine whether or not transmission of a document to a recipient is permitted, wherein scanning the e-mail message detects having the document embedded therein or attached thereto. Determination of whether a document is permitted to be transmitted to a recipient is not one of the limitations in claims **1** and **8 – 16**, and is not addressed in Tsuji and Ahern.

In paragraph 17 of the Office Action, in rejecting claims **17, 18, 35, 36, 59, 67** and **83**, the Examiner has indicated that Tsuji-Salzfass disclose examining a policy to determine whether or not transmission of a document is permitted, and causing transmission of the document to be blocked. Applicants respectfully submit that Tsuji and Salzfass do not address policy examination. Moreover, as indicated by the Examiner, Salzfass discloses notifying a sender that a recipient has a filter to block e-mails. As such, Salzfass discloses reception of a document being blocked, and not transmission of a document being blocked as in the claimed invention.

The rejections of the claims **1 – 36, 38 – 57, 59, 61 – 67, 69 – 76, 78 – 83** and **85 – 89** in paragraphs 4 - 17 of the Office Action will now be dealt with specifically.

As to amended independent method claim **1**, applicants respectfully submit that the limitation in claim **1** of

*"embedding a control mark ... within a static section of an electronic document, wherein the static section and the control mark remain unchanged when the electronic document is edited by a document editor"* is neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **2 – 18** depend from claim **1** and include additional features, applicants respectfully submit that claims **2 – 18** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **1 – 18** are deemed to be allowable.

As to amended independent claim **19** for a computer readable storage medium, applicants respectfully submit that the limitation in claim **19** of

*“an auto-marking module for embedding a control mark ... within a static section of an electronic document, wherein the static section and the control mark remain unchanged when the electronic document is edited by a document editor”*

is neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **20 – 36** depend from claim **19** and include additional features, applicants respectfully submit that claims **20 – 36** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **18 – 36** are deemed to be allowable.

As to amended independent method claim **38**, applicants respectfully submit that the limitations in claim **38** of

*“embedding a control mark ... within a static section of an electronic document, wherein the static section and the control mark remain unchanged when the electronic document is edited by a document editor”,*  
and

*“monitoring transmitted network packets, for detection of network packets containing the electronic document ...”*  
are neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **39 – 47** depend from claim **38** and include additional features, applicants respectfully submit that claims **39 – 47** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **38 – 47** are deemed to be allowable.

As to amended independent claim **48** for a computer readable storage medium, applicants respectfully submit that the limitations in claim **48** of

*"an auto-marking module for embedding a control mark ... within a static section of an electronic document, wherein the static section and the control mark remain unchanged when the electronic document is edited by a document editor", and*

*"a traffic monitor for ... detection of network packets containing the electronic document ..."*

are neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **49 – 57** depend from claim **48** and include additional features, applicants respectfully submit that claims **49 – 57** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **48 – 57** are deemed to be allowable.

As to amended independent method claim **59**, applicants respectfully submit that the limitations in claim **59** of

*"... wherein the specified electronic document includes a control mark within a static section thereof, wherein ... the static section and the control mark remain unchanged when the electronic document is edited by a document editor", and*

*"examining a policy to determine whether or not transmission of the document to a recipient is permitted ..."*

are neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **61 – 66** depend from claim **59** and include additional features, applicants respectfully submit that claims **61 – 66** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **59** and **61 – 66** are deemed to be allowable.



As to amended independent claim **67** for a computer readable storage medium, applicants respectfully submit that the limitations in claim **67** of

*"... wherein the specified electronic document includes a control mark within a static section thereof, wherein ... the static section and the control mark remain unchanged when the electronic document is edited by a document editor", and*

*"a policy manager for examining a policy to determine whether or not transmission of the specified electronic document to a recipient of an e-mail message is permitted"*

are neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **69 – 74** depend from claim **67** and include additional features, applicants respectfully submit that claims **69 – 74** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **67** and **69 – 74** are deemed to be allowable.

As to amended independent method claim **76**, applicants respectfully submit that the limitations in claim **76** of

*"scanning the intercepted network packets for detection of network packets containing a specified electronic document ...",*

*"... wherein the specified electronic document includes a control mark within a static section thereof, wherein ... the static section and the control mark remain unchanged when the electronic document is edited by a document editor", and*

*"examining a policy to determine whether or not transmission of the specified electronic document is permitted"*

are neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **78 – 82** depend from claim **76** and include additional features, applicants respectfully submit that claims **78 – 82** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **76** and **78 – 82** are deemed to be allowable.

As to amended independent claim **83** for a computer readable storage medium, applicants respectfully submit that the limitations in claim **83** of

*"a scanner for ... detecting network packets containing a specified electronic document",*

*"... wherein the specified electronic document includes a control mark within a static section thereof, wherein ... the static section and the control mark remain unchanged when the electronic document is edited by a document editor", and*

*"a policy manager for examining a policy to determine whether or not transmission of the specified electronic document is permitted"*

are neither shown nor suggested in Tsuji, Ahern, Scheier and Salzfass.

Because claims **85 – 89** depend from claim **83** and include additional features, applicants respectfully submit that claims **85 – 89** are not anticipated or rendered obvious by Tsuji, Ahern, Scheier, Salzfass or a combination of Tsuji, Ahern, Scheier and Salzfass.

Accordingly claims **83** and **85 – 89** are deemed to be allowable.

**Support for Amended Claims in Original Specification**

Independent claims **1, 19, 38, 48, 59, 67, 76** and **83** have been amended to include the limitation of the control mark remaining unchanged when the electronic document is edited. These limitations are supported in the original specification, at least at page 8, lines 15 - 27.

**CONCLUSION**

The undersigned representative respectfully submits that this application is in condition for allowance, and such disposition is earnestly solicited. If the Examiner believes that the prosecution might be advanced by discussing the application with the undersigned representative, in person or over the telephone, we welcome the opportunity to do so. In addition, if any additional fees are required in connection with the filing of this response, the Commissioner is hereby authorized to charge the same to Deposit Account 50-4402.

Respectfully submitted,

Date: April 24, 2009

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